

REMARKS

This Response is submitted in response to the Final Office Action mailed on April 25, 2003.

Claims 1-3 and 6-20 are pending. The Final Office Action rejects claims 1, 9 and 13 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,833,790 (“*Hare*”). Claims 3, 6-8, 10, 14, 15, 17 and 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Hare* in view of U.S. Patent No. 1,774,215 (“*Weinthrop*”). Claims 2 and 12 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Hare* in view of U.S. Patent No. 5,964,544 (“*Ko*”). Claim 11 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Hare* in view of U.S. Patent No. 5,988,685 (“*Mogelonsky*”).

Claim 16 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Hare* in view of *Weinthrop* and in further view of *Mogelonsky*. Claims 19 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Hare* in view of U.S. Patent No. 6,453,589 (“*Schwartz*”). In response, Claims 1, 9, 14 and 19 have been amended. Support for the amendments may be found on page 4, lines 26-28 of the Application, as well as the Figures, thus no new matter has been entered. As no new matter has been entered, Applicant respectfully submits that the present amendments do not raise any new issues and are made to place the claims in condition for allowance or in better form for appeal.

Claims 1, 9 and 13 are rejected under 35 U.S.C. §102(b) as being anticipated by *Hare*. Applicant submits this rejection is in error.

The Court of Appeals for the Federal Circuit has held that “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a *single* prior art reference.” *Verdegaal Bros v. Union Oil of California*, 814 F.2d 628, 631 (Fed. Cir. 1988) (*emphasis added*). It is without question the Patent Office has not met this standard. *Hare* merely relates to a folder which is capable of holding artwork. Contrary to the Patent Office’s assertion, *Hare* does not disclose or suggest “a semi-rigid body.” See Final Office Action at 2. As is made explicitly clear from the disclosure of *Hare*, the folder or sheet for holding the artwork is **flexible**. See Col. 3, line 64 – Col. 4, line 6 (*emphasis added*).

Hare similarly fails to disclose or suggest a dry erase board in which a user can write on a front side and a back side of the body at the same time. First, *Hare* does not disclose a dry erase surface. See Col. 7, lines 40-44. Moreover, as is evident from Figure 1 of *Hare*, there is no way that a user could write on both sides of the folder at the same time. Accordingly, Applicant respectfully submits that the rejection under 35 U.S.C. §102(b) has been overcome and request withdrawal of same.

Claims 3, 6-8, 10, 14, 15, 17 and 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Hare* in view *Weinthrop*. Applicant submits this rejection is not proper.

Weinthrop does not remedy the deficiencies of *Hare*. Nowhere does *Weinthrop* disclose or suggest a dry erase board including a body having opposed dry erase surfaces so that a user can write on a front side and a back side at the same time. *Weinthrop* merely relates to a folder made from a single blank of paper, a substance which is neither transparent nor dry erasable, thus if combined would render *Hare* inoperable. See Col. 1, line 20-23 and MPEP 2143.01. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. See MPEP 2141.03 and *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 f.2d 1540 (Fed. Cir. 1983) (*emphasis added*). Therefore, even if combinable *Weinthrop* clearly does not remedy the deficiencies of *Hare*. For example, the art fails to disclose or suggest a dry erase board including a body having opposed dry erase surfaces so that a user can write on a front side and a back side at the same time. Accordingly, Applicant respectfully submits Claims 3, 6-8, 10, 14, 15, 17 and 18 are patentable over all of the cited art and not properly rejected under 35 U.S.C. §103(a).

Claims 2 and 12 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Hare* in view *Weinthrop* and in further view of *Ko*. Applicant respectfully submits that *Ko* fails to remedy the deficiencies of *Winfrey* and *Weinthrop*. *Ko* merely relates to binders and shipping binders in a flat state. *Ko* fails to mention or suggest a dry erase board having opposed dry erase surfaces so that a user can write on a front side and a back side at the same time. This limitation is included in Claims 2 and 12. Accordingly, Applicant submits that this rejection under 35 U.S.C. §103(a) has been overcome.

Claims 11 and 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Hare* in view of *Mogelonsky* and *Hare* in view of *Weinthrop* and *Mogelonsky*, respectively. Applicant submits that *Mogelonsky* does not remedy the deficiencies of either of these combination of references as it also fails to disclose or suggest a dry erase board having opposed dry erase surfaces so that a user can write on a front side and a back side at the same time. In fact, *Mogelonsky* is completely silent as to any dry erasable surface. Accordingly, Applicant respectfully requests that this rejection under 35 U.S.C. §103(a) be withdrawn.

Claims 19 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Hare* as viewed with *Weinthrop*, and in further view of *Schwartz*. As discussed in detail above, *Hare* cannot be combined with *Weinthrop*. Moreover, *Schwartz* fails to remedy the deficiencies of either of these references as it is completely silent as to a dry erase board having opposed dry erase surfaces so that a user can write on a front side and a back side at the same time. Accordingly, Applicant submits that Claims 19 and 20 are allowable and not subject to rejection under 35 U.S.C. §103(a).

Applicant respectfully requests reconsideration of this patent application and earnestly solicit an early allowance of same.

Respectfully submitted,

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Date: June 24, 2003

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